



12-30-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

IN THE UNITED STATES PATENT AND TRADEM

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

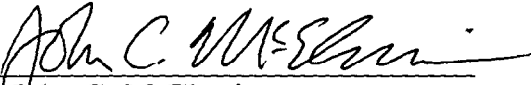
University of Southern California)	Opposition No.: 125,615
)	
Opposer,)	Serial No.: 75/358,031
)	
vs.)	Mark: "SC" (Stylized)
)	
University of South Carolina,)	
)	
Applicant.)	
)	
University of South Carolina)	Opposition No.: 125,615
)	
Petitioner,)	Reg. No.: 1,844,953
)	
vs.)	Mark: SC Word Mark
)	
University of Southern California)	
)	
Registrant.)	
)	

**APPLICANT AND PETITIONER'S MOTION TO STRIKE OR, IN THE
ALTERNATIVE, MOTION TO FILE A SURREPLY TO OPPOSER AND
REGISTRANT'S REPLY**

COMES NOW, the applicant and petitioner, University of South Carolina ("South Carolina"), pursuant to TMBP Section 502.03 and the cases cited therein, hereby requests that this Board strike from the record the "Opposer and Cross-Respondent's Reply in Support of Motion to Dismiss" and the materials submitted therewith (specifically including "Opposer and Cross-Respondent's Supplemental Request for Official Notice and Submission of Items Already of Record Pursuant to 37 C.F.R. § 2.122(b)). In the alternative, if South Carolina's Motion to Strike is denied, it moves to be allowed to file the surreply contained in its Memorandum in Support of its Motion to Strike submitted herewith.

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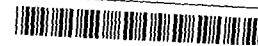
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Margaret Kraham

Date: 12/27/2002



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**PETITIONER'S MEMORANDUM IN SUPPORT OF ITS MOTION TO STRIKE OR,
IN THE ALTERNATIVE, SURREPLY MEMORANDUM IN OPPOSITION TO
REGISTRANT'S MOTION TO DISMISS**

I. INTRODUCTION

This dispute has arisen from the University of Southern California's ("California") Motion to Dismiss counterclaims for cancellation brought by the University of South Carolina ("South Carolina"). After briefs were filed by both sides on the issues relating to the Motion to Dismiss, California recently filed an additional Reply brief along with an extensive Supplemental Request For Official Notice, which submitted approximately 100 pages of new material for the first time.

In these Reply materials, California's original arguments were raised and recited without the introduction of any new issues.¹ In sum, California takes issue with the allegations of South Carolina's pleadings. Yet, California offers no case law that South Carolina's claims are barred as a matter of law. Instead, California seek to rely upon a mistaken view of the motion to dismiss standard and improperly submitted trademark records. In fact, the repetitive arguments contained in California's Reply brief only highlight the conspicuous *factual* disputes between the parties, thus giving the Board even more reason to deny California's Motion to Dismiss. Based on the complete lack of necessity for a recitation of California's previous arguments, South Carolina has moved for California's Reply brief and Supplemental Request for Official Notice to be stricken from the record. However, in the event that the Board decides to consider California's Reply brief and the materials submitted therewith, Carolina has moved in the alternative for the Board to consider the surreply contained in this Memorandum of law in an effort to preserve its position for the record in this case.

II. MOTION TO STRIKE

A. CALIFORNIA'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS IS IMPROPER AND SHOULD BE STRICKEN FROM THE RECORD.

It is within the Board's discretion as to whether a Reply brief is both proper and necessary under the circumstances. TMBP § 502.03. The Board may entertain a reply brief if, for example, such a brief is necessary to permit the moving party to respond to new issues raised in, or new materials submitted with, an adversary's brief in opposition to the motion.

¹ For purposes of illustration, in its Reply brief, California has reargued the following: (1) The letters "SC" are not an insignia within 15 U.S.C. §1052(b); (2) The letters "SC" do not uniquely identify the state of South Carolina; and (3) Carolina's allegations of fraud cannot survive a Motion to Dismiss. Each of these arguments was previously set forth in California's original brief and, as such, the Reply brief contains no new substantive material.

Id. However, it has been repeatedly held that reply briefs, which merely re-argue points made in previous briefs while addressing no new issues, should not be considered by the Board. SDT Inc. v. Patterson Dental Company, 1994 TTAB LEXIS 10, *4, 30 U.S.P.Q.2d 1707 (T.T.A.B. 1994); Wells Fargo & Company v. Lundeen & Associates, 1991 TTAB LEXIS 22, *3-4, 20 U.S.P.Q.2d 1156 (T.T.A.B. 1991); Johnston Pump/General Valve v. Chromalloy American Corporation, 1989 TTAB LEXIS 50, *6, 13 U.S.P.Q.2d 1719 (T.T.A.B. 1989); S & L Acquisition Company v. Helene Arpels, 1987 TTAB LEXIS 8, *4, 9 U.S.P.Q.2d 1221 (T.T.A.B. 1987). To that end, the Board has specifically stated that a party's arguments should be presented thoroughly in the context of a motion or the opposition brief thereto, as opposed to a reply brief. Johnston Pump, 1989 TTAB LEXIS 50 at *6.

In the present case, California's Reply brief rehashes nearly every one of its original arguments, while failing to either raise or address any new points. Moreover, the Plaintiff's Supplemental Request for Official Notice is an egregious attempt to submit pages of new material that should not even be considered on a motion to dismiss. As such, South Carolina respectfully moves that the Board strike the California's Reply brief and its Supplemental Request for Official Notice submitted therewith from the record as they have been improperly and unnecessarily submitted.

III. SURREPLY MEMORANDUM IN OPPOSITION TO MOTION TO DISMISS

A. IN THE ALTERNATIVE, IF CALIFORNIA'S REPLY BRIEF IS CONSIDERED, SOUTH CAROLINA REQUESTS THAT THE BOARD CONSIDER THIS SURREPLY TO PROTECT THE RECORD IN THIS CASE.

California's Reply brief should not be considered by the Board. However, if it is accepted and becomes part of the record, South Carolina requests that it be allowed to file the following surreply to adequately respond to California's repeated mischaracterizations:

In its Reply brief, California attempts to argue that because it has improperly submitted 11 trademark records showing the registration of the letter "SC" that it has established "as a matter of law" that South Carolina cannot have a claim under 15 U.S.C. Section 1052(a) or 1052(b). This assertion is incorrect. It flies in the face of established case law and runs contrary to the deferential standard shown to the plaintiff in a motion to dismiss.

If considered, the 11 submitted trademark records bear no direct relevance to this matter and should not be considered on a motion to dismiss. Moreover, as discussed above, the Board explicitly disfavors the submission of materials extrinsic to the pleadings with a Reply brief as California has attempted in this instance by its offering of a "Submission of Items Already of Record." Wells Fargo, 1991 TTAB 22 at *3-4. Further, South Carolina vigorously maintains its original position that all of California's extrinsic submissions should be disallowed since, pursuant to TMBP § 712.01 and 703.02(b), a party may not make a third-party registration part of the record simply by introducing lists of registrations or search reports where the registrations are mentioned.

South Carolina merely requests that the Board examine its causes of action under the proper legally recognized standard for a motion to dismiss. This standard requires that South Carolina's allegations be accepted as true and construed in a light most favorable to South Carolina. *See* TMBP § 503.02 (and cases cited therein). Regardless of how California attempts to depict this judicially mandated paradigm in its Reply brief, when the Board examines South Carolina's allegations under the proper standard, California's Motion to Dismiss must be denied.

South Carolina has put forth uncontroverted case law establishing that letters are not, as a matter of law, precluded as being insignia. In its Reply brief, California has gone to

great lengths to attack and distinguish the cases cited in South Carolina's prior brief relating to whether the letters "SC" may form an insignia within the meaning of 15 U.S.C. § 1052(b). However, these cases do represent that the Board has recognized that, in certain situations, letters can form an insignia. Further, California tries to assail In re: United States Rubber Co., 49 App. D.C. 376, 265 F. 1016, 1920 U.S. App. LEXIS 1506 (D.C. Ct. App. 1920) because of its age, yet contrary to California's argument, that case still remains good law. In fact, contrary to California's position, U.S. Navy v. United States Mfg. Co., 2 U.S.P.Q.2d 1254 (T.T.A.B. 1987), demonstrates that the issue of whether letters may form an insignia is not decided as a matter of law. Rather, it should more properly be considered as a factual issue requiring an adjudication by the Board. Since, as a matter of law, such a dispute exists as to whether letters may or may not form an insignia, the issue requires a *factual* determination and California's Motion to Dismiss must fail.

As to South Carolina's claim under 15 U.S.C. Section 1052(a), California has apparently suffered offense that South Carolina has the "nerve to make" allegations relating to the strong association of the letters "SC" with the state of South Carolina. **Reply brief, p. 5.** Certainly, residents in the state of California and the state of South Carolina will have wholly differing interpretations over the meaning of the letters "SC." Such differing viewpoints have created the heart of the factual dispute now before this Board.

However, despite its vehemence California, cannot and does not cite a single case to support its proposition that, as a matter of law, the letters "SC" cannot point uniquely to the State of South Carolina. In fact, California's proposition is clearly ridiculous, unless it had this issue had been litigated in the past. Here, South Carolina has satisfied its burden by alleging that the letters "SC" are uniquely associated with South Carolina. California disputes

this allegation solely on a factual basis; namely, that there are other uses of the letters "SC" that have somehow diluted the State of South Carolina's use. This is clearly insufficient.

As to California's repeated attacks on South Carolina's counterclaim of fraud, California once again makes arguments which are misplaced in the context of a motion to dismiss. For example, California argues at great length that its alleged misrepresentation was not material nor was it relied upon. However, issues of materiality and reliance obviously center upon the *facts* of the case. It is without question that South Carolina has affirmatively pled both reliance and materiality (along with the other elements of fraud) and, at this juncture, that is sufficient to defeat California's Motion to Dismiss because a factual dispute remains.

IV. CONCLUSION

At the outset, because it has been improperly submitted, South Carolina requests that California's Reply brief should be stricken from the record. It is clearly unnecessary as it has raised no new arguments. In the alternative, simply to protect itself (and the record) from California's attempts to gratuitously rehash its original contentions in its Motion to Dismiss, South Carolina asks the Board to consider its arguments set forth in this surreply. California has repeatedly attacked South Carolina's case on its factual merits. However, at this stage of the case and in light of the clear factual disputes, South Carolina has clearly set forth the necessary allegations in its Counterclaims which, if taken in a light most favorable to it, requires a denial of California's Motion to Dismiss.

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12/27, 2002

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Margaret Kraham
Margaret Kraham

Date: 12/27/2002

CERTIFICATE OF SERVICE

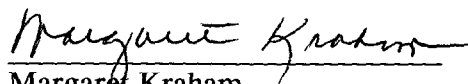
I, the undersigned Administrative Assistant of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings: APPLICANT AND PETITIONER'S MOTION TO STRIKE OR, IN THE ALTERNATIVE, MOTION TO FILE A SURREPLY TO OPPOSER AND REGISTRANT'S REPLY

PETITIONER'S MEMORANDUM IN SUPPORT OF ITS MOTION TO STRIKE OR, IN THE ALTERNATIVE, SURREPLY MEMORANDUM IN OPPOSITION TO REGISTRANT'S MOTION TO DISMISS

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December 27, 2002

BOX TTAB

NO FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: University of Southern California v. University of South Carolina
Our File No.: 13524/01501

Dear Assistant Commissioner:

Please find enclosed the **Applicant and Petitioner's Motion to Strike or, in the Alternative, Motion to File a Surreply to Opposer and Registrant's Reply and Petitioner's Memorandum in Support of Its Motion to Strike or, in the Alternative, Surreply Memorandum in Opposition to Registrant's Motion to Dismiss** in the above-referenced matter. By copy of this letter we are serving the opposing counsel.

Thank you for your assistance in this matter.

Very truly yours,

John C. McElwaine

JCM:mmk

Enclosures

cc: William H. Parham
Scott A. Edelman
Michael S. Adler